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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,672

02/23/2004

Michael P. Whitman

H-PM-00024 (1800-24)

2683

91478

7590

11/09/2010

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EXAMINER

WEEKS, GLORIA R

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

11/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,672	<b>Applicant(s)</b> WHITMAN ET AL.	
	<b>Examiner</b> GLORIA R. WEEKS	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 100 and 102-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 100 and 102-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to the remarks received on October 6, 2010.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

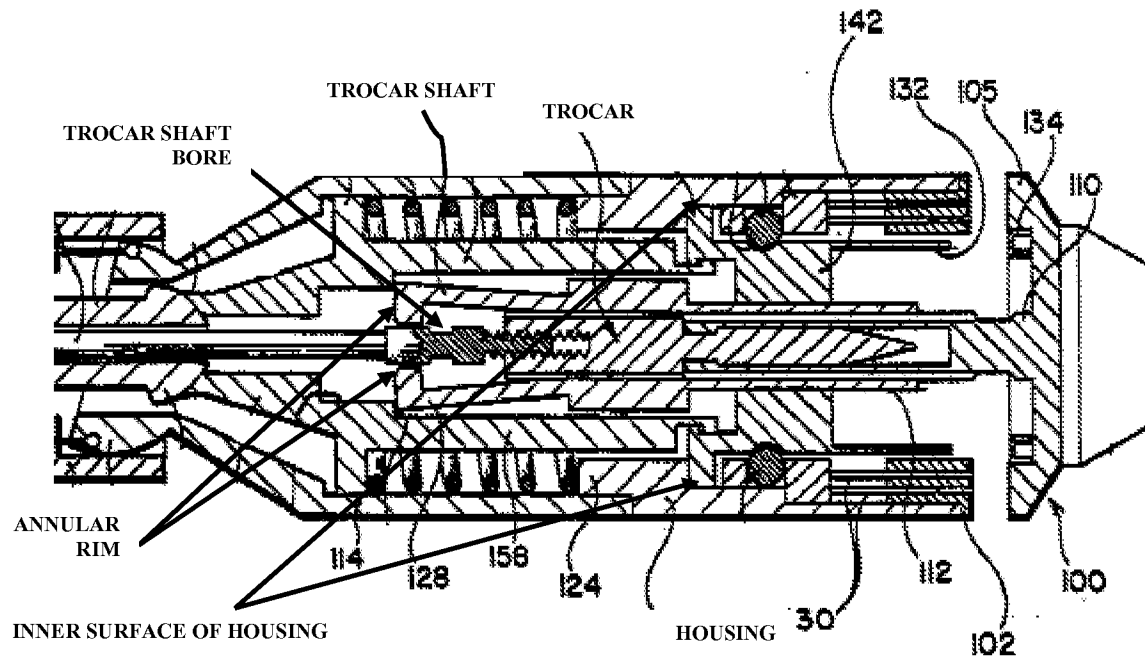
3. Claims 100, 102-104 and 106-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant et al. (USPN 5,609,285) in view of Balazs et al. (USPN 5,669,918) and Toledano (USPN 5,855,312).

In reference to claims 100, 102-104 and 106-109, Grant et al. discloses a surgical device, comprising: a staple housing 104 receiving a stapler cartridge 102, the housing 104 having an inner surface defining a bore (*see diagram of Grant et al. figure 18 below*) ; a rim 112 extending radially inward from the inner surface 124 of the housing 104 (figure 9-column 11 lines 49-52); a trocar shaft 128 defining a longitudinally extending bore disposed through the bore of the housing 104 and extends distally<sup>1</sup> relative to a clamping face (figures 6-7), so as to be moveable relative to the housing 104 by operation of at least one driver 84 by a first rotatable drive shaft 96, wherein the at least one driver 84 is within the housing 104; and an anvil 100 attachable to the trocar shaft 128 and configured to be moveable relative to the housing by movement of the trocar shaft 128

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<sup>1</sup> **dis·tal** (dɪsˈtɪl) *adj.* **1.** Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

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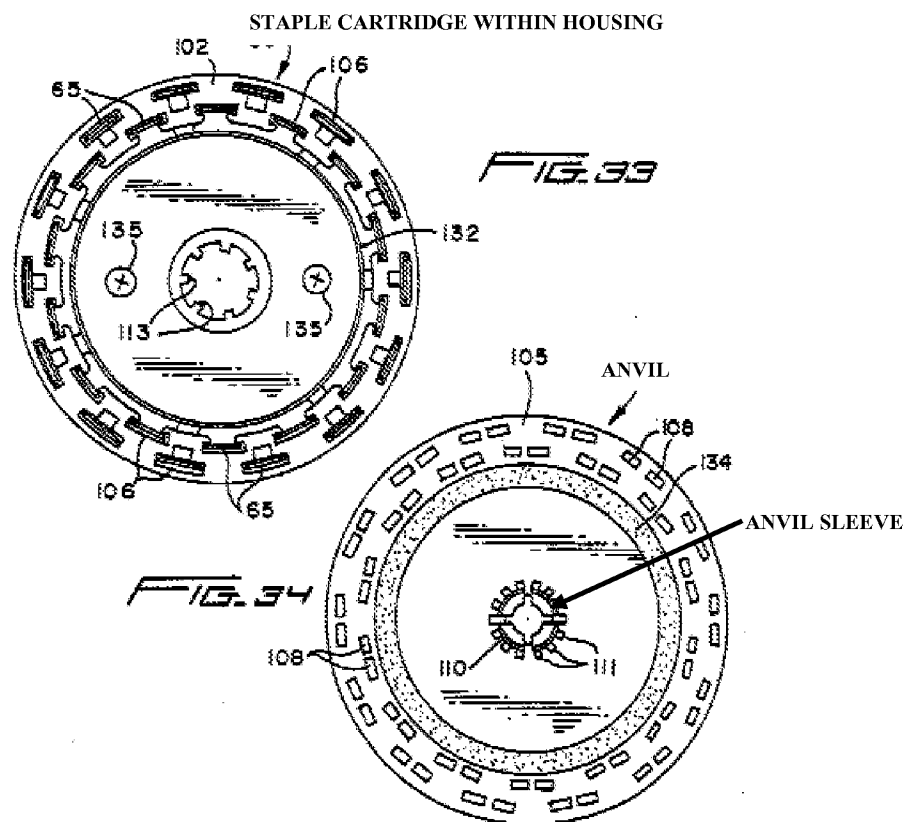
wherein the anvil 100 includes an anvil face 105 and an anvil sleeve 110 defining a trocar receiving slot (*see figure 34 diagram of Grant et al. below*) and the anvil sleeve 110 having at least a pair of axially extending slots 101 and a circumferential recess (defined by 111 segments-figure 34) receiving portion 113 of the rim 112 (column 13 line 64- column 14 line 14), wherein the anvil sleeve 110 is received within the bore of the trocar shaft (*see diagram above*); and a second driver 85 operable a second rotatable drive shaft 92 to drive staples from the staple housing 104.

Although Grant et al. discloses a plurality of recesses 111 that extend radially along the circumference of the anvil sleeve, wherein each recess receives an annular rim of the staples housing. Grant et al. does not disclose a single recess that extends radially around the anvil sleeve. Balazs et al. teaches a staple housing 30 including an inner surface having an annular rim 22 that extends radially within the housing ; and a sleeve 5 extending from an anvil 1, wherein the sleeve 5 has a recess 54 that extends radially around the circumference of the sleeve such that

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the annular rim 22 is received within the recess 54. Grant discloses the annular rim configured to engage a recess of the flexible cable driver 84, wherein the driver 84 is secured as an assembly with the trocar and the anvil sleeve such that there is no relative movement thereof, whereby engagement of the annular rim with the recess prevents movement of the anvil sleeve longitudinally within the trocar shaft bore. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the anvil sleeve of Grant et al. to include a circumferential recess that receives a circumferential rim of the staple housing, since Balazs et al. suggests that such a modification would firmly secure the anvil sleeve axially relative to the inner surface of the staple housing, just as Grant has disclosed with respect to the anvil sleeve assembly.

Grant et al. does not disclose the trocar shaft to include a flexible portion.



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Figure 1 and column 3 line 65- column 6 line 59 of Toledano teaches a surgical device, comprising: a staple housing defining a bore; a trocar shaft disposed through the bore of the housing and extends distally<sup>2</sup> relative to a clamping face, so as to be moveable relative to the housing by operation of at least one driver within the housing; and an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, wherein the anvil includes an anvil shaft 140, the anvil shaft defining a trocar receiving slot, and the trocar shaft including a flexible trocar 22 configured to be insertable within the trocar receiving slot and the trocar receiving slot is defined in an anvil sleeve 16 having an axially-extending bore in communication with the trocar receiving slot, wherein the axially-extending bore has a wide portion into which the flexible trocar is insertable and a narrow portion which retains the trocar 22 within the axially-extending bore. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the trocar shaft of Grant et al. to include a flexible portion, since column 4 lines 4-17 of Toledano states that such a modification improves the surgical conditions of closed surgery by enabling accurate alignment of a staple housing and anvil.

4. Claim 105 is rejected under 35 U.S.C. 103(a) as being obvious over Grant et al. (USPN 5,609,285) in view of Balazs et al. (USPN 5,669,918) and Toledano (USPN 5,855,312) as applied to claim 108 above, and further in view of Whitman (USPN 6,491,201).

Regarding claim 105, the modified apparatus of Grant et al. discloses a surgical instrument having a first driver and a second driver, each respectively manually actuated via a

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<sup>2</sup> **dis-tal** (dɪsˈtɑl) *adj.* **1.** Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

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first and second drive shaft; but Grant et al. does not disclose controlling rotation of each driver with a motor. Whitman teaches a surgical instrument having a flexible shaft (215) movable relative to a housing (155) by way of a rotatable driver (170) selectively rotated by at least one motor (165) via a controller (160). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the surgical instrument of Toledano include the motor rotatable driver of Whitman, as column 3 lines 17-31 of Whitman states that such a modification allows an operator to selectively and automatically control rotation of the driver.

Furthermore, It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.<sup>3</sup>

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 100 and 102-110 have been considered but are moot in view of the new ground(s) of rejection, necessitated by the amendments filed on October 6, 2010. Although Examiner has maintained the use of Grant et al, Balazs et al. and Toledano to reject the claimed invention, Examiner has modified the interpretation of the disclosure of Grant et al. such that the trocar shaft has now been defined as element 128 instead of 206. Element 128 is a tubular component of the surgical device of Grant et al. which receives an assembly of the trocar, cable driver, and anvil sleeve in a bore defined therein.

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<sup>3</sup> *In re Venner*, 120 USPQ 199.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations related to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLORIA R. WEEKS whose telephone number is (571)272-4473. The examiner can normally be reached on M-W & F 8:30am-12:30pm, 3:30pm-6:30pm and 9pm-10pm; Th 9am-2pm, 4pm-6pm and 9pm-10pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/  
Examiner, Art Unit 3721

/Rinaldi I Rada/  
Supervisory Patent Examiner, Art Unit  
3721

November 8, 2010